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In re Application of
OTA, Toshio et al
Application No.: 10/019,335
PCT No.: PCT/JP00/04517
Int. Filing Date: 06 July 2000
Priority Date: 08 July 1999
Attorney Docket No.: SHIM014
For: METHOD FOR CONSTRUCTING
FULL-LENGTH CDNA LIBRARIES

DECISION

This decision is in response to the papers submitted on 15 August 2002 which are treated as a petition under 37 CFR 1.182.

BACKGROUND

On 19 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided.

On 27 June 2002, applicants filed an executed declaration, the \$130.00 surcharge fee and a two-month petition and a \$400.00 extension fee. The name of the fourth named inventor was listed as OTSUKA, Kaoru on the declaration submitted while it is recorded on the international publication ("WO 01/04286") as SAITO, Kaoru.

On 29 July 2002, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) indicating that the declaration submitted on 29 August 2001 does not comply with 37 CFR 1.497 as the fourth inventor's name was spelled differently than listed on the international publication.

On 15 August 2002, applicants filed the instant response.

DISCUSSION

In the instant response, petitioner claims that the name change of the fourth inventor is due to marriage. Petitioner included a letter signed by Hatsushi Shimizu dated 27 December 2001 which indicates this change of the fourth inventor's name was

due to marriage. Nevertheless, this is not sufficient to meet the requirements outlined in the Manual of Patent Examining Procedures (MPEP). Section 605.04(c), *Inventor Changes Name*, of the MPEP states, in part:

The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Therefore, an affidavit signed by the inventor whose name has been changed is required to meet the requirements outlined above.

CONCLUSION

Accordingly, applicants' petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

It is noted that the surcharge fee of \$130.00 submitted with the instant response has been used as the \$130.00 petition fee. The surcharge fee pursuant to 37 CFR 1.492(e) was previously submitted on 27 June 2002.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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